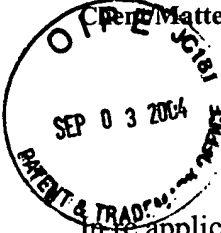


Attorney Docket No. NC13479

PATENT

Case Matter No. 9015.060



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : FUHRMANN ET AL.
Serial No. : 09/125,700
Filed : 23 October 1998
For : RADIOTELEPHONE
Group No. : 2684
Examiner : CHIANG, JACK

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Sir:

APPELLANTS' REPLY BRIEF ON APPEAL

This Reply Brief, filed (mailed) 30 August 2004, in response to the Examiner's Answer mailed 30 June 2004 is submitted in triplicate on behalf of Appellant for the application identified above. Please charge any additional necessary fees to Deposit Account No. 50-2032.

In addition to Appellants' Brief, dated 26 March 2004, Appellants wish to submit the following points raised by the Examiner's Answer:

STATUS OF THE CLAIMS

On page 3, § (3) of the Examiner's Answer, the Examiner stated that "[t]he statement of the status of the claims contained in the brief is incomplete", and added the conditional grounds for rejection appearing in paragraphs 7-10 of the Office Action mailed 27 August 2003, associated with the heading: "103 Rejection (If Fig. 6 is entered)". On page 2 of this same Office Action, however, appears the statement "**NOTE:** Fig. 6 and its description filed on 10-9-02 have not been entered (see the argument section below)." (The "argument section" contains only one reference to the proposed Figure 6: "In other words, this portion of the disclosure is not a support for the change in Fig. 6 and its description.") These statements appear contradictory, especially as the Examiner has reiterated the non-entry of proposed Figure 6 appearing on page 7 of the Examiner's Answer.

Appellants have specifically responded to the rejections that the Examiner stated were applicable. Appellants respectfully request that if the Examiner has altered his position, that the present state of the Application and the applicable rejections be set forth and Appellants given an opportunity to respond.

STATUS OF AMENDMENTS

In their Brief, Appellants stated that no amendments to the claims were filed following the final Office Action, which was mailed 27 August 2003.

In § (4) on page 4 of the Examiner's Answer, the Examiner stated this was incorrect, but without explanation. Appellants believe that their original statement was correct, but acknowledge that the Examiner may have answered with the proposed Figure 6 in mind, although this is nowhere stated. Clarification on this point is also requested.

SUMMARY OF THE INVENTION

In § (5) on page 4 of the Examiner's Answer, the Examiner stated that the Summary of the Invention in Applicant's Brief was deficient. Appellants disagree, and believe that the Examiner is not so much objecting to their characterization of the pending claims, but rather restating his rejections based on § 112, which Appellants have addressed elsewhere by traversing the Examiner's rejections.

ISSUES ON APPEAL

Appellants disagree with the Examiner's statement, in § (6) on page 5, that the rejections in paragraphs 7-9 of the Office Action are at issue in this Appeal. As pointed out by Appellants in their Brief, the Examiner conditionally drafted a rejection for use if "Fig. 6 is entered".

According to paragraph 1 of the Office Action, Figure 6 has not been entered. This rejection is therefore not an issue on Appeal.

Additionally, Appellants point out that no Amendment pursuant to § 1.116 in Response to the Office Action mailed on 27 August 2004 has been filed, much less entered for purposes of appeal. Appellants instead chose simply to file a Notice of Appeal, initiating the current proceeding.

To the extent that the Examiner related, for Appellants' benefit, potential rejections that might be made upon the occurrence of happening of certain events, Appellant's wish to express their gratitude for this courtesy. Appellants point out, however, that these events have not occurred. Notwithstanding the Examiner's good intentions, Appellants initiated this Appeal based on the then-current status of the prosecution as it was explained to them by the Examiner. Other actions available to Appellants at that time may no longer be available, and so they would be prejudiced if the Examiner is permitted to advance a new ground for rejection on appeal, contrary to 37 C.F.R. § 1.193(a)(2).

In fact, despite his statement in this section, the Examiner appears not to have asked for this new ground for rejection to be entered. On page 13 of the Examiner's Answer the Examiner reiterates that the grounds for rejection previously set forth in paragraphs 7-9 (presumably including paragraph 10) is conditioned in Figure 6 being entered. Neither Appellants nor the Examiner have asked that it be entered. Rather, Appellants request that the Appeal proceed on

the grounds framed as by the Examiner and relied on by Appellants in the Office Action of 27 August 2004.

ARGUMENT

Appellants' arguments relating to the issues properly in this Appeal are set forth in their Brief. In response the Examiner's Answer, however, the following additional points are presented for consideration.

First, it is apparent that the Examiner is insistent upon limiting the claims' scope to a certain embodiment, which he believes is completely set forth in Figure 5 of the Application. While such a limitation may make examination more convenient, Appellants have never agreed to it. In fact, they have explicitly taken issue with the Examiner's attempts to mischaracterize statements made in this regard. (*See, for example*, the Amendment dated 9 June 2003.)

The drawings in an Application, in fact, are simply meant to be an aid to understanding the invention. "The applicant shall furnish a drawing where necessary for the *understanding* of the subject matter to be patented." 35 U.S.C. §113 (emphasis added). This statute goes on to say that the Examiner may require such a drawing. Drawings filed after the filing date of the Application may not, of course, be used to overcome an insufficiency in the disclosure, but Appellants have not attempted to do so. (Nor have they been successful in having any additional drawings added for the purpose of aiding an understanding of the subject matter of the invention.)

Understanding of the subject matter of the invention does not entail, however, that each and every embodiment claimed be detailed in a separate drawing. In establishing that a proper disclosure has been made, an applicant may in fact rely on the Specification, the Drawings, and the Claims. *In re Wolfensperger*, 302 F.2d 950, 133 U.S.P.Q. 537 at 542 (C.C.P.A. 1962). There is no legal significance to whether the disclosure is found in the Specification or the Drawings. *Id.*

Appellants rely on the disclosure of their entire Application. As pointed out in their Brief, support for the currently claimed invention may be found, for example, on pages 1 and 2 of the Specification. Note that after a description of basic features on page 1 beginning at line 20, there are several other features recited that may optionally be present. This includes a recitation that a keymat be “held captive” between a second housing and the retaining retaining means, such as the components enumerated with reference numbers 14 and 3 in Figure 1. (*See the Specification at p. 2, lines 17-21.*) Although the key unit in Figure 1 is not shown as disposed in this fashion, that does not mean that the embodiment described in the Specification cannot be claimed.

And note that despite some variation in nomenclature, both Figures 1 and 5 illustrate a radiotelephone having in common (for example) a first housing, a second housing, a key unit, and a retaining means comprising a cover. The differences in the details of these two Figures, like the details of either of them taken in isolation, do not mean that embodiments described in the Specification (or the Claims) cannot be claimed simply because there is no drawing showing

precisely each feature in the described embodiment, and no other. The Drawings in the Application do provide adequate illustration, however, so that the subject matter of the claimed invention can be understood. This is what they are required to do.


CONCLUSION

None of the cited references, taken alone or in combination, show or suggest all of the features of the invention claimed in Groups A & B. Moreover, the pending claims are supported by the Specification and Drawings, if properly considered together, even without the entry of the proposed Figure 6 previously submitted but not approved by the Examiner. Therefore, the rejections under 35 U.S.C. §102 and §112 are improper. (By election of the Appellant and of the Examiner, no § 103 rejections are at issue on this Appeal.) The Appellants respectfully request that the Board of Appeals reverse the decision of the Examiner in which all of the pending claims of the Application were rejected.

Respectfully submitted,

Dated: 30 August 2004

SCHEEF & STONE, L.L.P.
5956 Sherry Lane, Suite 1400
Dallas, Texas 75225
Tel: (214) 706-4200
Fax: (214) 706-4242



Stephen J. Wyse, Reg. No. 40,880

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AF/2684



SCHEEF & STONE, L.L.P.

Legal counsel based on solid principles.

CERTIFICATE OF MAILING UNDER 37 CFR § 1.8

Date of Mailing: August 30, 2004

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August 30, 2004

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Sir:

In re: U.S. Serial No. 09/125,700
Inventor: Thomas Fuhrmann et al.
Title: **RADIOTELEPHONE**

Enclosed please find:

- ☒ Appellants' Reply Brief on Appeal (in triplicate); and
- ☒ Return post card
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication, or credit any overpayment, to Deposit Account No. 50-2032. A duplicate copy of this sheet is enclosed.
 - ☒ Any additional filing fees required under 37 CFR 1.16
 - ☒ Any patent application processing fees under 37 CFR 1.17

Respectfully submitted,

By: [Signature]
Stephen J. Wyse
Reg. No. 40,880
Attorney for Applicant

SCHEEF & STONE, L.L.P.
5956 Sherry Lane, Suite 1400
Dallas, Texas 75225
Tel: (214) 706-4200
Fax: (214) 706-4242